

Appl. No. 10/064,352
Reply to Office action of September 13, 2007

REMARKS

Request for Continued Examination:

The applicant respectfully requests continued examination of the above-indicated application as per 37 CFR 1.114.

5 Amendments to the Claims

Claims 1, 6, 12 and 14 are currently amended. Claims 4-5 and 13 are cancelled.

Claims 2 -3, 6- 9, and 15 -- 17 are original. No new matter is added by these amendments.

Consideration of all amendments is respectfully requested.

Claim Rejections – 35 U.S.C. 103(a)

10 Claims 1-4, 6-8, and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (US 6,859,614) in view of Romano et al. (US 5,586,306)

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (US 6,859,614) in view of Romano et al. (US 5,586,306), and further in view of Chau (US 5,870,087)

15 Claims 5, 13 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (US 6,859,614) and further in view of Yuen et al (US 2003/0190138)

Claims 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (US 6,859,614) in view of Romano et al. (US 5,586,306)

Response

20 Claim 1

Claim 1 has been amended to include limitations of Claims 4 and 5. With regards to the 103 rejection of Claim 5 as being unpatentable over Cho in view of

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Romano et al., and further in view of Yuen et al. (US 2003/0190138), the applicant believe the examiner misunderstood the claimed invention. The newly amended claim 1 recites "*the servo control and ECC decoder circuit comprises a register accessible by the graphics decoding circuit that indicates the location of decoded data in the external memory.*" However, fig. 5 of Yuen et al. merely show a directory controller in the external memory. On the contrary, the claimed invention is claimed as the servo control and ECC decoder circuit comprises a register to indicate the location of decoded data in the external memory. Thus, newly amended claim 1 is patentable over all cited prior art are taking alone or in combination.

10 In addition, the applicant disagrees with the statement that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine two memory controllers into one memory controller". The applicant wishes to cite *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), in which Nortron argued that the invention of Schenck merely integrated a machine that had previously been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas Schenck eliminated the need for dampening via the one-piece gapless support structure, showing insight contrary to the understandings and expectations of the art. In addition, MPEP 2142 states that, for 20 an obviousness rejection, "the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination". By utilizing a single memory controller, the system disclosed in Claim 1 overcomes the need for two separate RAM banks and reduces complexity and cost of production. As the use of the single memory controller is not simply an engineering choice but yields benefits not anticipated by the teachings of the prior art, the applicant respectfully asserts that the use of a single

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memory controller would not be obvious to a person of ordinary skill in the art. Furthermore, as stated above, the use of the single memory controller enables the servo control and EDD decoding circuit and the graphics decoding circuit to write data into the shared external memory. Therefore, the applicant respectfully asserts that

5 the single memory controller of Claim 1 overcomes the obviousness rejection.

In light of at least the reasons stated above, the applicant believes the claimed feature "*the servo control and ECC decoder circuit further comprises a register accessible by the graphics decoding circuit that indicates the location of decoded data in the external memory*" is neither taught nor suggested by teachings of Cho, in

10 view of Romano et al., and further in view of Yuen et al. (*emphasis added*). Reconsideration of Claim 1 is respectfully requested.

Claims 2 – 3 and 6 – 9

Claims 2 – 3 and 6 – 9 are dependent on Claim 1 and should be found allowable if Claim 1 is found allowable.

15 Claim 12

The newly amended Claim 12 has been amended to include limitations of Claim 13. Claim 12 discloses *the servo control and ECC decoder circuit comprises a first register indicating a first storage location in the external memory for the encoded data from the removable media, a second register indicating a second storage location in the external memory for the decoded data which is decoded from the encoded data, and a third register indicating a size of the decoded data*, whereas Cho, Romano et al., and Yuen et al. do not disclose the aforementioned limitations (as detailed in the response to Claim 1).

For at least aforementioned reasons, the applicant asserts that Claim 12 should be

25 found allowable over the prior art.

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Claims 14-17

Claims 14 – 17 are dependent on Claim 12. As the applicant believes Claim 12 has been placed in a position for allowance claims 15 – 17 should also be found allowable.

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Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Sincerely yours,

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